

REMARKS

Claims 1 - 11 are currently pending in the application. Claims 12 - 32 are cancelled without prejudice to the filing of a divisional application. By the foregoing, claim 1 is amended. The amended claim is supported by the originally filed application and contains no new matter.

Claim Rejections - 35 USC §102

Claims 1 - 10 were again rejected in the Action under 35 U.S.C. § 102(b) as anticipated by German reference 892 561 (DT '561). The Action states that the device of DT '561 teaches an engagement portion 1/5, a fastening portion having a hole 9, an axial projection 23 and a weight saving cavity. The Action also states that portions 1/5 and 9 are considered to comprise a plurality of structural units.

Applicant once again respectfully disagrees. For a claim to be anticipated by a prior art reference, the reference must teach **every element** of the claimed invention, either explicitly or inherently. As stated in the Declaration filed February 28, 2005, at paragraph 8, DT '561 discloses a device that fastens a chain ring to a pedal crank of a bicycle. A pedal crank 7/8 is fastened to the device 1 which in turn has a chain ring 11, 13 bolted to it.

The present invention claims a "sprocket support member for a bicycle sprocket assembly comprising at least one freewheel hub engagement portion having at least one tooth engagable with a splined surface of a bicycle freewheel hub and at least one fastening portion arranged in a radially external position with

respect to the engagement portion, the fastening portion presenting at least one hole for the mounting of at least one sprocket to the sprocket support member wherein the fastening portion is axially displaced with respect to the engagement portion." This is not taught or suggested by DT '561. As stated in the Valle Declaration submitted with the February 28, 2005 Reply, at paragraphs 10 - 12, the fastening device of DT '561 is used with a pedal crank that attaches to a spindle of the bottom bracket and a chainring, and does not disclose any means for coupling with a bicycle freewheel. As shown in Figure 2, the present invention comprises a splined engagement with a plurality of "teeth" 35 that engage a splined surface of a bicycle freewheel hub. The recited "at least one tooth" for this spline connection is wholly absent from DT'561. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 102 is therefore required.

Claim 11 was rejected by the Action under 35 U.S.C. § 103(a) as unpatentable over DT '561 in view U.S. Patent No. 6,102,821 to Nakamura. The Action states that DT '561 teaches substantially all that is claimed, but is unclear what the support is made of. The Action further states that Nakamura discloses that aluminum is a typical material for a sprocket support.

Nakamura fails to address the deficiencies noted above in the arguments regarding DT '561. Additionally, DT '561 is directed to a device for attaching a chainring to a pedal crank. Nakamura describes a multiple sprocket assembly having one or more sprocket subassemblies. Under 35 U.S.C. § 103, the claimed invention must be considered as a whole and the references must be considered as a

whole and must suggest the desirability and thus the obviousness of making the claimed invention. As stated in the Valle Declaration submitted with the reply filed February 28, 2005, at paragraphs 14 - 15, one of ordinary skill in the art would not have the motivation to combine the device for mounting a chainring to a pedal crank of DT '561 with the multiple sprocket assembly of Nakamura. Therefore, the Action has not established a *prima facie* case of obviousness. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 103 is respectfully requested.

The Action states at paragraph 5 that Applicant's arguments have been fully considered but are not persuasive. The Action also states that Applicant's argument that DT'561 is for fastening a chain ring to a pedal crank and that the instant invention is **for** coupling with a freewheel, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Further to the Valle Declaration submitted with the reply filed February 28, 2005, at paragraph 12, DT'561 cannot be used with a bicycle freewheel since it lacks any teeth that act as a freewheel hub engagement portion, which has been clarified in amended claim 1 which previously recited the "at least one tooth" to perform this function. Thus, a clear structural difference exists between DT'561 and the present invention.

The Action states at paragraph 6:

The Declaration under 1.132 filed is insufficient to overcome the rejections of claims 1-11 based upon anticipation and obviousness as set forth in the last Office Action because: The Declaration is not relevant to claims 1 - 10 which have been rejected under 35 U.S.C. § 102(b). Regarding claim 11, Declarant urges that one of ordinary skill in the art would combine the fastening device of DT'561 with the sprocket assembly of Nakamura. The rejection does not suggest combining these elements. Instead, the rejection relies on Nakamura for the specific (and well known) teaching that aluminum is a typical material for a sprocket support.

Applicant respectfully disagrees. In the Action dated September 1, 2004, the Examiner stated:

Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over DT'561 in view of Nakamura. As set forth above , DT'561 teaches substantially all that is claimed, but it is unclear what material the support is made of. Nakamura, however, discloses that aluminum (col. 1, line 40) is a typical material for a sprocket support.

Clearly, the Examiner has combined the DT'561 and Nakamura references to arrive at the subject matter of claim 11. In view the amendment to claim 1 and the above remarks, it is believed that DT'561 is no longer relevant, and thus the requirements under § 103 for some motivation must be found in the references themselves for the proposed combination.


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It is believed that the claims are allowable and a Notice of Allowance is respectfully requested. Should the Examiner believe that any minor issues need to be addressed, the Examiner is invited to contact the undersigned at the Examiner's convenience. Alternatively, Applicant will proceed with an Appeal for the reasons noted above.

In view of the foregoing amendment and remarks, Applicant respectfully submits that the present application, including claims 1 - 11, is in condition for allowance and a notice to that effect is respectfully requested.

Respectfully submitted,

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